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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,495	06/28/2001	Shinichi Yamada	057250903	5364

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,495

Applicant(s)

YAMADA ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of Amendment filed on January 29, 2003. Claims 19-81 are pending. Claim rejection under 35 U.S.C. § 112, first paragraph, is withdrawn in view of applicants' remarks and further consideration. Claim rejection under § 112, second paragraph is withdrawn in view of claim amendments. Claim rejections under § 102 are withdrawn in view of applicants' remarks. Claim rejections under § 103 have been modified to meet the amended limitation in claim 55, but otherwise maintained for the reasons of record as indicated in the previous Office action dated January 17, 2003. New rejection is also made in view of the claim amendment. Claim rejection under obviousness double patenting is withdrawn in view of further consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 55 recites "a C₁₆-C₆₀ fatty acid chosen from 18-methyleicosanoic acid". The limitation is vague and indefinite since it is not clear whether the term "18-methyleicosanoic acid" is a claimed limitation. Claim 55 presents a range within a range.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 19-29, 32-54, and 56-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maubru (US 6312674 B1) in view of Bergmann (US 6110450) and Dubief et al. (US 6120757) ("Dubief").

Maubru teaches oxidizing composition for bleaching or permanent reshaping hair, wherein the composition comprises ceramides disclosed in col. 3, line 21 – col. 16, line 13. The reference specifically teaches bis(N-hydroxyethyl-N-cetyl)malonamide and 2-N-oleoylaminoctadecane-1,3-diol. See col. 5, lines 1 – 16. See instant claims 25-29. It is noted that oxidizing composition is used in "fixing step" in the permanent waving/straightening process. See col. 1, lines 1-29. Adding cationic polymers as a cosmetic additive is also suggested. See col. 5, lines 54 – 58; instant claim 19, 57, 64, and 74. The reference further teaches that the invention may contain other additives that are "known for their use in oxidizing compositions for bleaching or permanent reshaping of the hair", and that the invention may be modified in the form of shampoo. See col. 5, lines 44 – 49. The claimed process of treating is necessarily practiced when the composition is used according to the teaching in the prior art.

Maubru fails to teach fatty alcohol or the specific cationic polymers of instant claims.

Bergmann teaches hair treatment composition comprising ceramides and phytantriol, which is useful for hair treatment. See abstract. The reference teaches that using cationic polymers or ceramides for hair treatment is well known in the art. See

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col. 1, line 16 – 48. The ceramide of instant claims are used in Bergmann. See col. 2, line 26 – col. 5, line 39. Adding cationic quaternary ammonium surfactant, fatty alcohol, and/or vitamins is also suggested. See col. 2, line 3 – 10; col. 5, lines 40 - 43; col. 6, lines 27 – 34. See instant claims 35 and 55. The invention may be used with permanent waving reducing or “fixing” agents. See col. 6, line 50 – col. 7, line 26. See also Examples 1 and 2.

Bergmann fails to teach the specific quaternary ammonium surfactants of instant claims.

Dubief teaches aqueous dispersion comprising quaternary ammonium surfactants, which is useful for hair cosmetic compositions. See col. 4, line 51 – col. 6, line 2; see instant claims 35-51. The reference discloses that the invention can be used in permanent waving or straightening products or for washing or rinsing. See col. 6, lines 50 – 58.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by the recited teachings, the instant claims define nothing more than the concomitant use of hair care ingredients. It would follow that the recited claims define prima facie obvious subject matter. Cf. In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

In this case, given the general teaching in Maubru that conventional additives for oxidizing composition for hair can be employed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Bergmann and Restle for specific additives such as fatty alcohol and quaternary ammonium surfactants. The motivation to combine the ingredients to successfully formulate a hair composition for topical application is found in the teachings of the prior arts that these are old and well known for hair treatment purposes. See In re Kerkhoven. Nothing nonobvious or unexpected is seen in combining conventional ingredients used for same purposes. See MPEP § 718.02.

2. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maubru, Bergmann, and Dubief as applied to claims 19-29, 32-54, and 56-81 above, and further in view of Critchley et al. (US 5198210) ("Critchley").

Maubru, Bergmann, and Dubief are discussed above. The combined references fail to teach isocetyl or isostearyl alcohol.

Critchley teaches cosmetic compositions for skin, hair and nails which contains synthetic ceramides and emollients such as isocetyl alcohol, stearyl alcohol and cetyl alcohol. See col. 1, line 11 – col. 6, line 51; col. 10, lines 44 – 61.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Dubief I by substituting the stearyl alcohol and cetyl alcohol with isocetyl alcohol, as suggested by Critchley, because of the expectation of successfully producing hair care products with similar emolliency effects.

3. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maubru, Bergmann, and Dubief as applied to claims 19-29, 32-54, and 56-81 above, and further in view of Ochiai et al. (US 5587155) ("Ochiai").

Maubru, Bergmann, and Dubief fail to teach 18-methyleicosanoic acid.

Ochiai teaches hair conditioning composition comprising 18-methyleicosanoic acid. See Table 3; Example 7; col. 1, line 54 – col. 2, line 54. See col. 7, lines 36 – col. 8, line 60 for the application of the invention.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding a well known hair conditioning ingredient such as 18-methyleicosanoic acid as motivated by Ochiai because of the expectation of successfully producing a hair conditioning composition with enhanced effects.

Response to Arguments

Applicant's arguments with respect to claims 19-85 have been considered but are not persuasive.

Applicants argue that the Maubru, Bergmann, and Dubief fail to teach liquid fatty alcohol. Examiner notes that the Bergmann reference teaches in col. 6, lines 58 – 62, to use "natural, hydrogenated or unhydrogenated, synthetic or non-synthetic hydrocarbon oils which are cyclic aliphatic, linear or branched saturated or unsaturated and soluble or insoluble, fatty alcohols". In view of this suggestion, examiner takes the position that the selection of liquid fatty alcohol in this case is obvious.

For the examiner's proposed motivation to substitute the isostearyl and isocetyl alcohols with the stearyl and cetyl alcohols used in Bergmann, applicants argue that there is no clear and particular evidence showing motivation to modify or combine the references. Examiner reiterates that Critchley teaches to employ emollients such as the isostearyl and isocetyl fatty alcohols. Applicants also noted that the reference also indicated that Critchley teaches to use either liquid or solid emollients in col. 10, lines 39-41. Bergmann suggests that using either solid or liquid fatty alcohols for hair conditioning agents would have been obvious to a skilled artisan. There seems to be nothing nonobvious or unexpected in selecting isocetyl or isostearyl alcohol in place of the fatty alcohol used in Bergmann, absent clear and convincing evidence of unexpected results.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
April 6, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER
4/7/03